

Remarks

These Remarks are in reply to the Office Action mailed December 21, 2004. Claims 1, 4-22, 30-35 and 37-49 were pending in the Application prior to the outstanding Office Action. No claims are currently being amended, canceled or added. Thus, claims 1, 4-22, 30-35 and 37-49 remain for the Examiner's consideration, with claims 1, 8, 14, 15, 21, 37, 44, 46 and 48 being independent. Reconsideration and withdrawal of the rejections are respectfully requested.

I. Summary of Claim Rejections under 35 U.S.C. 103(a)

Claims 1, 4-22, 30-35 and 37-39 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lee (U.S. Patent No. 4,789,801).

In Section 6 of the Office Action, it was admitted that "Lee does not teach the inner second electrodes being a greater distance downstream from the first array than the outermost second electrodes." However, it was alleged in the Office Action that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the distance of the second electrodes to the first would have been an art-recognized variable determined by routine experimentation."

Further, in Section 7 of the Office Action (entitled "Response to Arguments"), the Examiner again agrees that "Lee does not teach the inner second electrodes being at a greater distance downstream from the first array than the outermost second electrodes." However, it is alleged that "a slight rearrangement of the second electrodes with respect to each other would not have significant patentable weight. Moreover, how the electrodes are positioned would have insignificant patentable weight since the position of a part would have been determined by routine experimentation."

II. Summary of Examiner Interview

Applicants would like to thank Examiner Tran and Supervisory Examiner Sedleck for the Examiner Interview with Applicants' representatives Jeffrey Kurin and Sheldon Meyer on January 27, 2005. During the interview Applicants' representatives expressed their view that the Examiner has provided insufficient suggestion or motivation for modifying Lee to produce the claimed invention. No agreement was reached during the interview.

III. Discussion of Rejections and Claims

As explained in great detail in Applicants' previous Replies, when the nose of all the second electrodes are the same distance from the first electrode array (e.g., as shown in FIG. 5B of the present application), the electrode field at the noses of the inner second electrodes (e.g., 242-2 and 242-3 in FIG. 5B) will be greater than the electric field at the noses of the outermost second electrodes (e.g., 242-1 and 242-4 in FIG. 5B). This is because, as was explained, the electric field produced at the nose of each second electrode is proportional to the quantity of ions that contact the nose of the second electrode and the distance ions travel before reaching the nose of the second electrode. In accordance with embodiments of the present invention, by moving the inner or middle second electrodes further downstream, (e.g., as shown in FIG. 6B of the present application), and as required by claim 1, the additional distance that ions must travel to reach the noses of the outer or middle second electrodes will substantially offset the additional number of ions received at the noses of the inner second electrode. This should result in a substantially even or similar electric field generated at the nose (i.e., most upstream portion) of each of the second electrodes, as explained in paragraph [0080] of the specification.

Applicants again respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness. As explained in MPEP 2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Examiner has explicitly admitted that the applied prior art reference does not teach the inner second electrodes being positioned at a greater distance downstream from the first array than the outermost second electrodes. Nevertheless, without providing any support or rationale, the Examiner has asserted that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the distance of the second electrodes to the first would have been an art-recognized variable determined by routine experimentation." Again, without any support or rationale, the Examiner asserted that "a slight rearrangement of the second electrodes with respect to each other would not have significant patentable weight" and that "how the electrodes are positioned would have insignificant patentable weight since the position of a part would have been determined by routine experimentation."

Applicants respectfully disagree that the claimed configuration of the second electrodes would have been obvious. The Examiner has cited no case law or MPEP section that states that the Examiner's general assertion is sufficient to establish a *prima facie* case of obviousness. Further, the Examiner has not pointed to any suggestion or motivation in the prior art to produce the claimed invention.

It appears that the Examiner may have been alluding to MPEP § 2144.04.IV.B entitled "*Changes in Shapes*" in rejecting the claims. For the convenience of the Examiner, MPEP 2144.04.IV.B is shown below.

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

To paraphrase, *In re Dailey* stands for the proposition that changes in shape may be held obvious, absent persuasive evidence that the particular claimed configuration was significant. On the contrary, Applicants assert that they have provided persuasive evidence that the particular claimed configuration of the second array of electrodes is **significant**, as explained in detail above. More specifically, as explained above, by moving the inner or middle second electrodes further downstream, (e.g., as shown in FIG. 6B of the present application), and as required by claim 1, the additional distance that ions must travel to reach the noses of the outer or middle second electrodes will substantially offset the additional number of ions received at the noses of the inner second electrode, which should result in a substantially even or similar electric field generated at the nose (i.e., most upstream portion) of each of the second electrodes, as explained in paragraph [0080] of the specification.

It is also possible that the Examiner may have been alluding to MPEP § 2144.04.VI.C entitled "*Rearrangement of Parts*" in rejecting the claims. However, as explained in this section of the MPEP "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of

obviousness. The **prior art must provide a motivation or reason** for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

As pointed out by the Federal Circuit in *In re Fritch*, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). If the Examiner is to maintain this rejection, Applicants respectfully request that the Examiner point out where the prior art suggests positioning the inner second electrodes at a greater distance downstream from the first array than the outermost second electrodes.

Claims 4-7, 30 and 39 depend from and add additional features to claim 1. Applicants assert that claims 4-7, 30 and 39 are patentable for at least the reasons discussed above with regard to claim 1, and for the features that they add. Accordingly, Applicants respectfully request that the rejections of these claims also be withdrawn.

Additionally, for reasons similar to those discussed above with regards to claim 1, Applicants also assert that Lee does not obviate claims 8-10, 14-17, 20-21, 31-35, 37-38 and 40-49.

IV. Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 (order no. SHPR-01041USQ) for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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